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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,536	05/18/2005	Zion Azar	127/04496	6013

44909 7590 02/26/2010

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EXAMINER	
RALIS, STEPHEN J	
ART UNIT	PAPER NUMBER
3742	
MAIL DATE	DELIVERY MODE
02/26/2010	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZION AZAR and PINCHAS SHALEV

Appeal 2009-008826
Application 10/535,536
Technology Center 3700

Decided: February 26, 2010

Before JENNIFER D. BAHR, JOHN C. KERINS
and STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

Opinion of the Board filed by BAHR, *Administrative Patent Judge*.

Dissenting Opinion filed by McCARTHY, *Administrative Patent Judge*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 7, 9-11, 13-16 and 18-36. We have jurisdiction under 35 U.S.C. § 6(b). We do not sustain the final rejections of claims 7, 10, 11, 13 and 15 under 35 U.S.C. § 102(b) as being anticipated by Kelman (WO 92/16338, publ. Oct. 1, 1992); of claims 9 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Kelman and Iderosa (US 5,065,515, issued Nov. 19, 1991); and of claims 16 and 18-36 under § 103(a) as being unpatentable over Kelman and Bermingham (US 3,045,345, issued Jul. 24, 1962). We summarily affirm the provisional rejection of claims 7 and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Application 11/571,753 (published on August 27, 2009 as US 2009-0211101 A1).

Claims 7 and 11 are independent:

> 7. A hair cutting apparatus comprising a structure adapted for contacting an area of skin having hair, the apparatus comprising:
>
> a) a heated elongate element heated to a temperature sufficient to cut hair, mounted on the structure; and
>
> b) an electrostatically charged element adapted for collecting hair.
>
> 11. A method of collecting cut hair, comprising:
>
> a) cutting hair with a heated elongate element; and

b) collecting the hair cuttings from the skin of the user with an electrostatically charged element.

The Obviousness-type Double Patenting Rejection

The Appellants have not addressed, or even acknowledged, the double patenting rejection of claims 7 and 11 in either the Appeal Brief or the Reply Brief. The Appellants failed to address this rejection even though the Examiner pointed out in the Answer that the rejection remains at issue in the appeal. (*See* Ans. 3). The Examiner has not withdrawn the obviousness-type double patenting rejection. That rejection is part of the "decision of the primary examiner" which the Board shall review on appeal. *See* 35 U.S.C. §§ 6 (b) and 134(a). Since the Appellants provide no reason why claims 7 and 11 might be patentable over claim 1 of Application 11/571,753, the rejection is affirmed.

The Examiner's attention is drawn to section 804 I.B.1. of the MANUAL OF PATENT EXAMINING PROCEDURE (8th ed., rev. 7, July 2008) in connection with further proceedings in the present application.[1]

The Rejections under 35 U.S.C. §§ 102 and 103

Kelman discloses a hair cutting apparatus including a laser source *14* and laser beam transfer optics *16*. The laser beam transfer optics *16* direct a laser beam generated by the laser source *14* onto hairs *19* to be cut by the shaver. (Kelman 5, ll. 2-9). Kelman's drawing figures depict the laser beam

[1] Our decision to summarily affirm this rejection does not preclude the Examiner from withdrawing the rejection pursuant to United States Patent and Trademark Office policy, in the event that the Examiner determines that the claims in the present application are otherwise allowable.

as performing either a hair cutting function in which the beam approaches the skin surface at a relatively sharp angle or a shaving function in which the beam approaches the skin surface at a relatively shallow angle. (*Compare* Kelman, fig. 4 *with id.*, figs. 2A-3B). Kelman discloses combining the laser source *14* and the laser transfer optics *16* with an electrostatic apparatus for collecting loose hair. (Kelman 6, l. 24 – 7, l. 3).

The Examiner finds that either Kelman's laser beam or the air in the path of Kelman's laser beam is a "heated elongate element heated to a temperature sufficient to cut hair" as recited in claim 7 and a "heated elongate element" used for cutting hair as recited in claim 11. (Ans. 4-5 and 10). The Examiner premises this finding either on Kelman's disclosure that the laser beam is sufficiently energized to vaporize or carbonize the hair to be cut (*see* Kelman, 5, ll. 18-24) or on the understanding that the laser beam significantly heats the air along or near the path of the beam. (Ans. 10-11). The Appellants dispute the premises underlying the Examiner's findings. (Reply Br. 2-4).

The Examiner erred in finding that either Kelman's laser beam or the air in the path of Kelman's laser beam is a "heated elongate element heated to a temperature sufficient to cut hair" as recited in claim 7 and a "heated elongate element" used for cutting hair as recited in claim 11. The Appellants do not dispute that Kelman's laser beam is sufficiently energized to vaporize or carbonize hair. The Examiner fails to provide a sound basis for belief that the laser beam is necessarily a heated element, however. As the Appellants point out, a laser beam might transfer energy to an object in the form of electromagnetic waves. The hair or skin irradiated by the laser beam may absorb the electromagnetic waves to convert the energy into the

form of heat. (Reply Br. 3). Since the laser beam itself need not transfer energy in the form of heat, the beam is not inherently a heated elongate element, much less a heated elongate element heated to a temperature sufficient to cut hair.

Neither has the Examiner provided a sound basis for belief that the laser beam necessarily either heats the air in the path of the beam to a temperature sufficient to cut hairs recited in claim 7 or that the air in the path of the beam cuts hair as recited in claim 11. As the Appellants point out, it would be undesirable for a laser beam to dissipate energy in the form of heat to the air in which the beam travels. Such energy dissipation would quickly attenuate the laser beam itself. (Reply Br. 3). The Examiner provides no evidence that the air in the path of a laser beam would be heated to a temperature sufficient to cut hair. Neither does the Examiner provide technical reasoning sufficient to show that such a degree of heating of the surrounding air would be susceptible of instant and unquestionable demonstration as being well-known.

Therefore, we do not sustain the Examiner's finding that Kelman anticipates either independent claim 7, independent claim 11 or dependent claims 10, 13 and 15. The Examiner erred in rejecting claims 7, 10, 11, 13 and 15 under § 102(b) as being anticipated by Kelman.

Iderosa discloses a shaving device *10* including a cutting blade *12* and either a laser device *14* or a heating element *15* having a rounded or beveled heating edge *32* for heating the hair to be cut to facilitate cutting by the cutting blade *12*. (Iderosa, col. 2, ll. 63-67 and col. 3, l. 52 – col. 4, l. 9). Iderosa discloses neither the use of the laser device *14* or the heating element *15* to cut hair nor that the heating element *15* is heated to a temperature

sufficient to cut hair. The Examiner fails to provide reasoning explaining how the teachings of Iderosa might remedy the deficiency of Kelman in failing to disclose a "heated elongate element heated to a temperature sufficient to cut hair," as incorporated by reference into claim 9 from claim 7, or a "heated elongate element" used for cutting hair, as incorporated by reference into claim 14 from claim 11. The Examiner erred in rejecting claims 9 and 14 under § 103(a) as being unpatentable over Kelman and Iderosa.

Bermingham discloses an electronic shaving head including a tubular cutter member *20* and a U-shaped shear plate *14* including openings *16* for allowing hair outside the shear plate *14* to contact the cutting member *20* inside the shear plate *14*. (Bermingham, col. 1, ll. 49-64). Bermingham does not disclose any element heated to a temperature sufficient to cut hair. The Examiner fails to provide reasoning explaining how the teachings of Bermingham might remedy the deficiency of Kelman in failing to disclose a "heated elongate element heated to a temperature sufficient to cut hair," as incorporated by reference into claims 18-23 from claim 7, or a "heated elongate element" used for cutting hair, as incorporated by reference into claims 16 and 24-36 from claim 11. The Examiner erred in rejecting claims 16 and 18-36 under § 103(a) as being unpatentable over Kelman and Bermingham.

DECISION

We REVERSE the Examiner's decision as to claims 9, 10, 13-16 and 18-36. We AFFIRM the Examiner's decision as to claims 7 and 11.

AFFIRMED-IN-PART

McCARTHY, *Administrative Patent Judge*, dissenting,

I join in the majority opinion with respect to the rejections under 35 U.S.C. §§ 102 and 103.

I disagree with the summary affirmance of the provisional rejection of claims 7 and 11 under the judicially created doctrine of obviousness-type double patenting. We are reversing all of the final rejections entered in the present application. Furthermore, the present application has an earlier filing date than Application 11/571,753. When the only rejection remaining in an application is a provisional obviousness-type double patenting rejection over a claim of a later-filed application, Patent and Trademark Office policy favors withdrawal of the rejection. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 804 I.B.1. (8th ed., rev. 7, July 2008). The Board does not have the authority to withdraw a rejection.

The decision whether to enter additional rejections against the claims of the application or to withdraw the provisional double-patenting rejection lies with the Examiner. As the record now stands, withdrawal may be appropriate. If the Examiner chooses to withdraw the provisional rejection, the propriety of the rejection will become moot. Under these circumstances, we have the authority to decline to address the rejection.

Our decision to summarily affirm the provisional rejection of claims 7 and 11 will become part of the prosecution history of any patent which might issue from this application, even if the provisional rejection is subsequently withdrawn. What effect this summary affirmance might have (or should have) on any such patent, if any, cannot be predicted with certainty. I would not judge the propriety of the provisional double

patenting rejection, even by default, before providing the Examiner an opportunity to determine whether the rejection should be withdrawn.

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